## REMARKS

In the Office Action of October 4, 2004, claims 1-10, 13, 14, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,273,887 to Yamauchi et al. in view of U.S. Patent No. 6,241,726 to Raymond Chia et al. Additionally, claims 11, 12, 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Yamauchi and Raymond Chia patents further in view of U.S. Patent No. 5,680,860 to Imran.

In the above application, claims 1, 5, 10 and 14 are independent claims and each of the remaining claims depend from one of these independent claims. Claims 1 and 10 have been amended. Applicant views this amendment as clarification of the language of the claims, and not an added limitation of the claim language.

Independent claim 1 requires, inter alia, in addition to first and second elongated ablation electrodes, "a pair of EKG monitoring sensors on the tip spaced distally from its associated ablation electrode for contacting cardiac tissue and being adapted to be connected to an EKG monitor, so that when cardiac tissue is grasped between the first and second jaws, the EKG sensors contact the cardiac tissue and transmit the signals

generated by the tissue to the EKG monitor" (emphasis added). Independent claims 5, 10 and 14 also contain a similar feature.

In the Office Action, Figure 74b of the Yamauchi patent is relied upon for teaching all the limitations of the claims except for an EKG sensor. Raymond Chia is relied upon in combination with Yamauchi to supply the missing teaching or suggestion of an EKG sensor. However, it is respectfully submitted that Raymond Chia fails to teach or suggest the claimed invention. It is further respectfully submitted that there is no motivation to make the alleged combination based on the teachings of these references and the knowledge of those skilled in the relevant field.

First, it is respectfully submitted that when the relevant portion of Raymond Chia is read in context, it does not teach or suggest a device as recited in the claims. In the Office Action, Raymond Chia is apparently relied upon for its limited disclosure of an EKG sensor as follows: "the conducting wire [20] is externally connected to an EKG 41 for diagnosis or to a RF generator 42 during an electrophysiology ablation procedure" (Column 7, lines 63-65). In Figure 3 of Raymond Chia, a conducting wire 20 is connected to each electrode 14 and 15.

Based on this limited disclosure of Raymond Chia, a logical understanding of Raymond Chia is that the electrodes 14 and 15

either both act as EKG sensors or both act as electrodes. Raymond Chia clearly does not teach or suggest any device which is capable of monitoring non-ablated tissue while simultaneously ablating tissue. Raymond Chia teaches and suggests an entirely different structure -- indicating that the electrodes 14 and 15 can perform the ablation of tissue or perform a separate diagnostic function of tissue (Col. 7, lines 59-67). Both functions are performed by the same structure, i.e., the electrodes 14 and 15. Thus, the electrodes 14 and 15 simply cannot act as a pair of EKG monitoring sensors which are spaced distally from the electrodes so as to monitor tissue using a separate structure than those which perform ablation operations.

Applicants emphasize that Raymond Chia is silent as to any benefit or utility being associated with a separate EKG monitoring sensor spaced beyond the electrodes. Why should Raymond Chia need separate EKG sensors? The reference already discloses that the electrodes 14 and 15 are either connected to a EKG monitor for diagnostically monitoring electrical signals or connected to an RF generator for ablating tissue. For these reasons, applicants respectfully request that Raymond Chia, even in combination with Yamauchi, does not teach or suggest the claimed subject matter.

Further, applicant emphasizes that there is no teaching or suggestion to combine the Raymond Chia and Yamauchi references. In Raymond Chia, an intravascular catheter system is disclosed which comprises outer and inner catheter sheaths, 1 and 12, respectively. Raymond Chia's inner catheter sheath 12 is a flexible elongate tubular member for maneuvering through a vein or artery (column 2, lines 14-20).

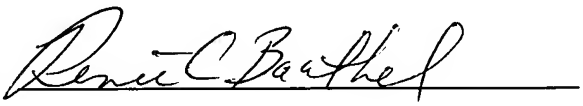
In Yamauchi, two pivotal, relatively-movable, opposed jaws 548a and 548b are disclosed and must be sufficiently rigid for grasping externally opposed tissue surfaces. Non-insulated, incision projections 549a and 549b are aligned on opposed jaws (see Figure 74b) and are disposed on the opposed sides of the tissue when tissue is grasped between the jaws.

It would not be obvious to combine the flexible, intravascular catheter system disclosed in Raymond Chia with the opposed, pivotal, grasping jaws 548a and 548b in Yamauchi. Raymond Chia's structure is not intended to grip opposite sides of the tissue. It is a catheter system for treating the internal surfaces of a vein or artery. There is no motivation in either reference to combine an instrument solely for use within the interior of a vessel with an instrument for use external to a vessel.

For these reasons, it is respectfully submitted that Yamauchi and Raymond Chia are not properly combinable and that claims 1, 5, 10 and 14 should be allowable. The respective dependent claims include all of the features of their respective independent claims and it is respectfully submitted that these claims also are not anticipated or would not be obvious over the cited references.

Reconsideration and allowance of claims 1-18 are respectfully requested.

Respectfully submitted,

Date: January 4, 2005 By: 

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